

REMARKS

Claims 1-39 remain pending and under current examination.

In the Office Action,¹ the Examiner rejected claims 1, 11, 12, 18, and 29 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,594,799 to Robertson et al. ("Robertson").

Applicant thanks the Examiner for withdrawing the rejections under 35 U.S.C. §§ 102 and 103 set forth in the Office Action mailed March 21, 2005. Applicant respectfully traverses the Examiner's rejections in the last Office Action for the following reasons.

I. Rejection of claims 1, 11, 12, 18, and 29 under 35 U.S.C. § 112, second paragraph

Applicant respectfully traverses the rejection of claims 1, 11, 12, 18, and 29 under 35 U.S.C. § 112. In rejecting each of these claims, the Office Action asserts that selected language in each of claims 1, 11, 12, 18, and 29 is "unclear," but no basis for such assertion is given. Applicant submits that the language of these claims is clear and would be readily understood by one of ordinary skill in the art. Since the Office Action does not otherwise point out why claims 1, 11, 12, 18, and 29 are vague or indefinite, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

In any event, in order to assist the Examiner's understanding of claim 1, Applicant respectfully directs the Examiner's attention to Applicant's disclosure at, for example, paragraphs 25 and 26 (Fig. 2, items 202 and 204) and in paragraph 32 (Fig. 6), for a discussion of exemplary procedures to retrieve metrics from a metrics

database. Further, Applicant's disclosure at, for example, paragraph 27 (Fig. 2, item 206 and Fig. 4) discusses exemplary methods for determining a set of unique tags from the set of tags using identification attributes. With respect to claim 11, Applicant directs the Examiner's attention to Applicant's disclosure at, for example, paragraphs 25 and 26 (Fig. 2, items 202 and 204) and in paragraph 32 (Fig. 6), which discuss exemplary procedures to initiate retrieval of metrics from a metrics database. Further, Applicant's disclosure at, for example, paragraph 28 (Fig. 2, steps 208 and 210) and at paragraphs 33 and 34 (Fig. 7) discusses exemplary methods for selecting and combining like additive attributes to produce a set of group attributes. Further, in regard to claims 12, 18, and 29, Applicant directs the Examiner's attention to Applicant's disclosure at, for example, paragraph 27 (Fig. 2, item 206 and Fig. 4), which discusses exemplary methods for determining a set of unique tags from the set of tags using identification attributes.

II. Rejection of claims 1-39 under 35 U.S.C. § 102(e) as being anticipated by *Robertson*

Applicant respectfully traverses the rejection of claims 1-39 under 35 U.S.C. § 102(e) as anticipated by *Robertson*. In order to properly establish that *Robertson* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See

(...continued)

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9

U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Robertson does not disclose each and every element of Applicant's claimed invention. Claim 1 recites a combination including, for example:

providing a metrics database comprising metrics data that describes characteristics of a software product;

...
initiating a procedure comprising instructions to retrieve from the metrics database a set of tags and to determine a subset of unique tags from the set of tags based on a condition.

(Emphasis added).

Robertson fails to teach or suggest at least "initiating a procedure comprising instructions to retrieve from the metrics database a set of tags in response to the query," as recited by claim 1. The Examiner asserts that *Robertson* teaches this element in "col. 13, lines 18-45; also see 'portal site' 240 and method steps of fig.9" (Office Action at p. 3). Applicant respectfully disagrees that the cited teachings of *Robertson* disclose the claimed "set of tags." *Robertson* does not explicitly teach a "set of tags" as recited by claim 1, nor has the Examiner identified any teachings of *Robertson* that constitute the claimed "set of tags."

Moreover, the cited portions of *Robertson* teach, among other things, retrieving data from a business database 250 and an affinity data base 242. Significantly, however, the cited portion of *Robertson* is silent as to retrieving any data from a metrics database. Accordingly, *Robertson* fails to teach the claimed method including "initiating a procedure comprising instructions to retrieve from the metrics database a set of tags in response to the query," for this additional reason.

Further, *Robertson* fails to teach or suggest determining “a subset of unique tags from the set of tags based on a condition,” as also recited by claim 1. The Examiner asserts that *Robertson* teaches this element in “col. 13, lines 18-45; also see ‘portal site’ 240 and method steps of fig.9” (Office Action at p. 3). As discussed above, *Robertson* does not teach or suggest a “set of tags” or a “set of tags” in a metric database. As such, *Robertson* also does not teach, either expressly or inherently, “determining a subset of unique tags from the set of tags based on a condition,” as further recited by claim 1.

Moreover, *Robertson* fails to teach or suggest at least “providing a metrics database comprising metrics data that describes characteristics of a software product,” as further recited by claim 1. The Examiner asserts that *Robertson*’s metrics database 238 (Fig. 2) meets this element (Office Action at p. 3). *Robertson*, however, teaches that “metrics server … data may include … web traffic patterns, application usage, component usage, … and user rating feedback” (*Robertson*, col. 9, lines 16-21). *Robertson* also teaches in col. 15, lines 60-65 that “metrics data may include prior component purchases and prior site navigation or usage patterns” (emphasis added). Such teachings of *Robertson*, however, do not constitute a teaching or suggestion of “providing a metrics database comprising metrics data that describes characteristics of a software product,” as further recited in claim 1.

For at least the reasons discussed above, claim 1 is allowable over *Robertson* and claims 2-10 are allowable at least due to their dependency from claim 1. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claims 1-10 under 35 U.S.C. § 102(e) as being anticipated by *Robertson*.

Moreover, the Examiner has not indicated any portion of *Robertson* that allegedly teaches or suggests the elements of claim 3 (Office Action at p. 4). Accordingly, Applicant respectfully submits that claim 3 is allowable. Should the Examiner introduce a new ground of rejection for claim 3, Applicant requests that the subsequent Office Action be made non-final in accordance with M.P.E.P. § 706.07(a) because Applicant has not amended any claim.

Independent claims 11 and 12, although of different scope, recite elements similar to claim 1. For example, claim 11 recites a combination including “providing a metrics database comprising metrics data that describes characteristics of a software product; [and] … initiating a procedure comprising instructions to retrieve from the metrics database a set of tags.” Claim 12, for example, recites a combination including an interface module “to retrieve from a metrics database a set of tags … and to determine a subset of unique tags from the set of tags based on a condition.”

Accordingly, for at least the reasons discussed above with respect to claim 1, *Robertson* cannot anticipate independent claims 11 and 12 or dependent claims 13-16. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claims 11-16 under 35 U.S.C. § 102(e) as being anticipated by *Robertson*.

Robertson also does not disclose each and every element of claim 17. Applicant notes that claim 17 recites a combination including, for example:

a group tag;
a set of tag identifiers; and
a command for grouping a set of metrics data wherein, upon reading the command, the interface module initiates a grouping module for:
 retrieving a set of tags corresponding to the set of tag identifier;
 retrieving a set of additive attributes associated

with the set of tags;
combining like additive attributes from the set
of additive attributes to produce a set of group
attributes, and
assigning the group tag to the set of group
attributes

(Emphasis added).

The Office Action does not set forth in detail how *Robertson* allegedly teaches or suggests “a group tag,” “tag identifiers,” “set of metrics data,” “a grouping module,” “a set of tags,” “a set of additive attributes,” or “a set of group attributes,” as recited by claim 17. In particular, to reject claim 17, the Office Action includes brief citations to *Robertson*, but does not otherwise indicate how such citation relates to the language of claim 17 (see Office Action at p. 7).

Applicant respectfully notes that pursuant to M.P.E.P. § 706, “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” Applicant respectfully requests that the Examiner clearly articulate how the prior art allegedly teaches or suggests each and every element recited by Applicant’s claims, such that Applicant may be given a full and fair opportunity to reply. Since the Office Action does not adequately address claim 17, Applicant submits that the rejection based on *Robertson* should be withdrawn at least for this reason.

Moreover, neither the cited portion of *Robertson*, nor any other portion thereof, teaches or suggests at least “a group tag,” “tag identifiers,” “set of metrics data,” “a grouping module,” “a set of tags,” “a set of additive attributes,” or “a set of group

attributes," as recited by claim 17. Accordingly, claim 17 is also allowable over

Robertson.

Independent claims 18, 28, 29, and 39, although of different scope, recite elements similar to elements recited by independent claim 17. Claims 19-27 and 30-38 depend from independent claims 18 and 29. Accordingly, claims 18-39 are allowable over *Robertson* at least for the reasons discussed above regarding claim 17.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Should the Examiner continue to dispute the patentability of the claims after consideration of this Reply, Applicant encourages the Examiner to contact Applicant's undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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